



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,838	06/26/2002	Tobias Kaufhold	GK-ZEI-3149/500343.20150	4197

26418 7590 06/21/2005

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

AWAD, AMR A

ART UNIT	PAPER NUMBER
----------	--------------

2675

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,838

Applicant(s)

KAUFHOLD ET AL.

Examiner

Amr Awad

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Glaser et al. (US patent NO. 4,202,037; hereinafter referred to as Glaser).

As to independent claim 6, Glaser (figures 1-6) teaches an optical observation instrument (microscope 11) that includes at least one eyepiece (viewing means 22) having an intermediate image plane (figures 4a-4c), and a device for displaying information relating to the adjusted instrument parameters, the current operating state and/or the object to be observed (specimen 28) in a visually perceptible manner being arranged in the intermediate image plane (col. 5, line 10 through col. 6, line 10).

As to claim 9, as can be seen in figures 4a-4c, Glaser shows that the information for the observer is perceptible in the eyepiece outside the image field area for observing of the specimen (col. 5, lines 10-44).

As to claim 10, as best understood by the examiner, claim 10 is substantially similar to independent claim 6 because the device is used for different specimen.

As to claim 11, the claim is substantially similar to claim 10, and would be analyzed similarly.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glaser. Glaser teaches all the limitations of claim 7 except the citation of having LED display or LCD display connected to the control electronics. However, as seen in figure 1 a graphic display 19 connected to the controller 17. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the graphic display 19 as LED or LCD display so as to reduce the size of the display as well as to reduce the power consumption.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glaser in view of Sakano (US patent NO. 6,292,214).

As can be seen above, Glaser teaches all the limitations of claim 8 except the citation of having the control electronics are integrated in the eyepiece tube and are connected to the central operating device.

However, Sakano (figure 1) shows a microscope (100) wherein a controller (36) is connected to the central operating device (the optical part of the microscope), and integrated within the microscope device (10) (col. 6, lines 50-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Sakano having the controller integrated with the microscope to be incorporated to Glaser's device so as to reduce the number of separately located items in the device, which will increase the portability of the device.

Response to Arguments

Applicant's arguments filed 1/24/2005 have been fully considered but they are not persuasive.

Applicant (bottom of page 4) argued that Glaser does not teach or suggest disclose a device that provides an object to be observed in a visually perceptible manner arranged in the intermediate image plane. Examiner respectfully disagrees. The term "perceptible" is translated to "capable of being perceived". The term Perceive is translated to "to attain awareness or understanding of" (Merriam Webster Online Dictionary). Therefore, any image or object that can be understood or aware by the observer is called to be perceptual. The Office Action above states, "the object to be observed (specimen 28) in a visually perceptible manner being arranged in the intermediate image plane (col. 5, line 10 through col. 6, line 10)". Therefore, the observed object (Specimen 28) can be visually perceptible to the observer. The image that is superimposed upon an image display taught by Glaser is created by the object (Specimen 28) viewed by the observer.

Applicant (top of page 5) argued that Glaser does not provide that the image plane for the information display is being in the eyepiece. Examiner respectfully

Art Unit: 2675

disagrees. The eyepiece is interpreted by the Examiner as the portion in which the observer is looking at with his eyes. In Glaser's device, the ocular 12 in figure 1 is considered to be the eyepiece. Therefore, the Examiner believes that the claimed invention is fairly taught by the cited reference. With respect the limitation cited in claim 10 of having the eyepiece constructed with respect to shape, size, and fastening means in a same manner which is the same as an eyepiece not having such a device. The examiner believes that this limitation is vague, and as best understood by the Examiner simply means that, the eyepiece has standard size or shape used in other device, which is inherently taught by the Microscope 11 in Glaser's device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (571) 272-7764.

Art Unit: 2675

The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571)272-3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. A.

**AMR A. AWAD
PRIMARY EXAMINER**

